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REMARKS

Examiner said that claim 27 involved an invention that is distinct from that of claims 1-26 and requested Applicant to restrict the application to one invention. Applicants agreed to do so by withdrawing claim 27 and have done so in this reply.

Examiner rejected claims 1, 4-8, 14, and 17-21 under 35 U.S.C. §103(a) as being unpatentable over Decasper et al. in view of Coley et al.

As per claim 1 and 14, Examiner said that the Association Identification Unit (AIU) of Decasper et al. stores information pertaining to a flow and filter information or rules. This is not so. Packets received by Decasper et al. are stored in a stack (page 5, line 2). The AIU stores filters not rules (page 5, line 1). When a packet is received by Decasper et al., it is stored in a stack and presented to the filters (page 4, line 13) of the AIU so that the packet may be sent to an appropriate Toolkit Module for further processing (page 4, line 13 and page 5, line 1). Examiner equates the filters to rules. However, the filters do not contain rules but the same fields as the flow with the information in some fields replaced with wildcards (page 4, lines 15-16). Decasper et al. does not include rules for acceptance or rejection as do Applicants. Decasper et al. accepts every packet and makes no judgment concerning acceptability as do Applicants. Decasper et al. merely concerns itself with directing flows to appropriate modules for further processing. Decasper et al. does not determine whether or not a packets should be allowed or denied access as do Applicants. Applicants disclose a method of making access and denial decisions in an efficient manner (page 11, lines 14 to page 12, line 2).

The AIU also associates the packets in a flow with one another by tagging subsequent packets that pertain to a flow with an identifier (page 5, lines 2-3). The first packet in a flow will

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be unknown. Decasper et al. handles first packets in a flow by automatically accepting it and creating a new flow enter or identifier and mapping the flow to an appropriate packet filter (page 4, lines 4-6) and does not compute anything as Examiner said. The flow identifier is only used to associate packets in a flow so that they get processed by the same filter, not to allow or deny access to further processing as do Applicants (page 20, claim 1), and not as an approval list as Examiner stated. Examiner said that Decasper et al. performs a match and the packet is allowed to pass. Decasper et al. does not mention a match for the purpose of determining whether or not to grant access to a packet.

Examiner said that it is inherent that Decasper et al. initializes the AIU or database. The AIU is not a database but a back of filters with the ability to place an identifier on subsequent packets in a flow.

It is the burden of the U.S. Patent & Trademark Office to establish a *prima facie* case of obviousness when rejecting claims under 35 U.S.C. §103. *In re Reuter*, 210 USPQ 249 (CCPA 1981). Decasper et al. is inoperable as a method of making access or denial decisions as do Applicants and, therefore, Decasper et al. is defective for the purpose relied upon by Examiner. *In re Hoehsema*, 158 USPQ 596 (CCPA 1968). The mere absence from Decasper et al of an explicit requirement to make access and denial determinations cannot reasonably be construed as an affirmative statement that [the requirement is in the reference]. *In re Evanega*, 4 USPQ2d 1249. There is no suggestion in Decasper et al. to deny access to a packet. If the prior art does not provide the impetus to do what the inventor had done then Examiner's case of *prima facie* obviousness fails. *In re Herschler*, 200 USPQ 711. Examiner said that it would have been obvious to modify Decasper et al. to arrive at Applicants method. However, Decasper et al. does not suggest such modifications. A prior art reference cannot provide the motivation for making a

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modification if the suggestion for the proposed modification does not come from the prior art reference. In re Gordon, 221 USPQ 1127 (Fed. Cir. 1984). Decasper et al. includes no logical reasoning or justification for modifying their method. There must be some logical reason apparent from the evidence of record that would justify a...modification of references. In re Regel, 188 USPQ 132. Examiner reduces Applicants' method to the idea of allowing or denying access to a patent. The invention cannot be tested on the basis of whether the "idea" is patentable. Under the patent statute, Title 35 U.S.C., "ideas" are not patentable; claimed structures and methods are. Reducing a claimed invention to an "idea," and then determining patentability of that "idea" is error. Analysis properly begins with the claims, for they measure and define the invention. The "difference" may have seemed slight (as has often been the case with some of history's great inventions, e.g., the telephone), but it may also have been the key to success and advancement in the art resulting from the invention. Further, it is irrelevant in determining obviousness that all or all other aspects of the claim may have been well known in the art. Jones v. Hardy, 220 USPQ 1021 (Fed. Cir. 1984). At best, in view of these disclosures, one skilled in the art might find it obvious to try various...[modifications]...However, this is not the standard of 35 U.S.C. section 103. In re Goodwin, 198 USPQ 1. Proper claim construction demands interpretation of the entire claim in context, not a single element in isolation. Hockerson-Halberstadt, Inc. v. Converse, Inc., Fed. Cir. No. 98-1501, 7/20/99. Differences between an invention and the prior art cited against it cannot be ignored...Under section 103, [Examiner] cannot dissect a claim, excise [a claim limitation] from it, and declare the remaining portion of the mutilated claim to be unpatentable. The claims must be read as a whole. If [Examiner] meant to disregard that basic principle of claim interpretation, [the court] must reverse as a matter of law. In re Gulack, 217 USPQ 401 (Fed. Cir. 1983). One important

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indicium of non-obviousness is "teaching away" from the claimed invention by the prior art...at (and/or after) the time the invention was made. U.S. v. Adams, 148 USPQ 479 (1966). Decasper et al. discloses a method of steering packets and not a method of determining acceptability of a packet as do Applicants and, therefore, teaches away from Applicants' method.

Examiner admits that Decasper et al. does not disclose a disapproved list. However, Examiner said that Coley et al. discloses a disapprove list. Coley requires a series of tests for determining accessibility (Fig. 4A and Fig. 4B). Having to execute a series of tests for each packet is very inefficient. Applicants' method is an improvement over such an inefficient system. Instead of executing a series of tests on every packet presented to it, Applicants initialize a database with approved and disapproved flow tags that are used to determine accessibility (page 20, claim 1), not identification of one packet with another of the same flow. Applicants also compute a flow tag, not a flow identifier, for any flow that is not pre-approved or pre-disapproved. So, Applicants' method only does a computation when it is presented with a new flow and not for every packet presented to it (page 11, line 14 to page 12, line 2). Therefore, Applicants' method is more efficient than that of Coley et al.

Examiner said that it would have been obvious to add a means for discarding a packet. This is not what Applicants have done. Applicants have invented an efficient method of allowing or denying access to a computer that does not require each and every packet presented thereto to be tested. This improvement is not found in Coley et al., Decasper et al., or the combination thereof.

It is the burden of the U.S. Patent & Trademark Office to establish a prima facie case of obviousness when rejecting claims under 35 U.S.C. §103. In re Reuter, 210 USPQ 249 (CCPA 1981). Coley et al. is inoperable as a method of allowing or denying access where tests are made

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only for never-before-seen packets as Applicants' method and, therefore, Coley et al. is defective for the purpose relied upon by Examiner. In re Hoehsema, 158 USPQ 596 (CCPA 1968). Neither Decasper et al. nor Coley et al. suggests the combination or modification suggested by Examiner. The method Examiner tries to create by combining Decasper et al. and Colet et al. only comes from Applicants' specification. Examiner may not combine references if the suggestion to combine the references comes from Applicant's own specification. In re Jansson, 203 USPQ 976 (CCPA 1979). The combination and modifications suggested by Examiner destroys the intended function of both Decasper et al and Coley et al. References are not properly combinable or modifiable if their intended function is destroyed. In re Gordon, 221 USPQ 1125(fed. Cir. 1984). Neither Decasper et al. nor Coley et al. include any reasoning for the combination and modifications suggested by Examiner. There must be some logical reason apparent from the evidence of record that would justify a...modification of references. In re Regel, 188 USPQ 132. A prior art reference cannot provide the motivation for making a modification if the suggestion for the proposed modification does not come from the prior art reference. In re Gordon, 221 USPQ 1127 (Fed. Cir. 1984). At best, in view of these disclosures, one skilled in the art might find it obvious to try various...[modifications]...However, this is not the standard of 35 U.S.C. section 103. In re Goodwin, 198 USPQ 1. Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching, suggestion, or incentive supporting the combination. ACS Hospital Systems, Inc. v. Montefiore Hospital, 221 USPQ 929 (Fed. Cir. 1984). Neither Decsaper et al. nor Coley et al. includes such teaching, suggestion, or incentive. If the prior art does not provide the impetus to do what the inventor had done then Examiner's case of *prima facie* obviousness fails. In re Herschler, 200 USPQ 711. Even if all elements of a claimed invention are disclosed in various prior art references, the claimed invention taken as a whole cannot be said to be obvious without some reason given in the prior art why one of ordinary skill would have been prompted to combine the teachings of the references to arrive at the claimed invention. In re Regel, 188 USPQ 132 (CCPA 1975). Examiner has not found such a reason in the prior art. Examiner merely said that it would have

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been obvious to modify the prior art references to obtain Applicants' method. This is not the standard for determining obviousness.

As per claims 4 and 17, Examiner said that Coley et al. discloses the processing of IP packets. Claims 4 and 17 are dependent on claims 1 and 14, respectively, and contain all of the limitations of the claims on which they depend. Therefore, for the reasons outlined above, Applicants submit that Examiner's rejections of claims 1 and 14 are improper and, therefore, Examiner's rejections of claims 4 and 17 are improper as well.

As per claims 5 and 18, Examiner said that Decasper et al. discloses receiving packets associated with an identifier, creating an identifier for each new flow, storing the new identifier, and allowing the packet access to the system. As outlined above, Decasper et al. uses as identifier to associate packets within a flow so that such packets may be presented to the same filter so that all of the packets in a flow are processes by the same Toolkit Module and does not use the identifier to make any determination as to accessibility of the packet. Decasper et al. grant access to all packets. Furthermore, claims 5 and 18 are dependent on claims 1 and 14, respectively, and contain all of the limitations of the claims on which they depend. Therefore, for the reasons outlined above, Applicants submit that Examiner's rejections of claims 1 and 14 are improper and, therefore, Examiner's rejections of claims 5 and 18 are improper as well.

As per claims 6 and 19, Examiner admits that neither Decasper et al. nor Coley et al. disclose recording each allowed access. However, Examiner took official notice that such a concept is obvious and that it would have been obvious to do so. Concepts are not patentable. Applicants have not proposed a concept but a combination of steps, which is patentable subject matter. Claims 6 and 19 are dependent on claims 1 and 14, respectively, and contain all of the limitations of the claims on which they depend. Therefore, for the reasons outlined above,

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Applicants submit that Examiner's rejections of claims 1 and 14 are improper and, therefore, Examiner's rejections of claims 6 and 19 are improper as well. Furthermore, would have been obvious is not the standard. (cite).

As per claims 7, 8, 20, and 21, Examiner admits that neither Decasper et al. nor Coley et al. disclose alerting a system administrator if the number of discarded packets exceeds a user-definable threshold within a user-definable span of time. However, Examiner took official notice that such a concept is obvious and that it would have been obvious to do so. Concepts are not patentable. Applicants have not proposed a concept but a combination of steps, which is patentable subject matter. Claims 7, 8, 20, and 21 are dependent on claims 1 and 6, and claims 14 and 19, respectively, and contain all of the limitations of the claims on which they depend. Therefore, for the reasons outlined above, Applicants submit that Examiner's rejections of claims 1, 6, 14, and 19 are improper and, therefore, Examiner's rejections of claims 7, 8, 20, and 21 are improper as well.

Applicants amend their application in light of Examiner's request for election and offer rebuttal to Examiner's rejections. Applicants submit that their application is now in condition for allowance.

Reconsideration of the application in light of the amendment and rebuttal is requested.  
Allowance of claims 1-26 is solicited.

Respectfully submitted,



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